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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,278	03/04/2002	Stephen Donovan	HACK:016US	9538

7590 03/29/2004

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EXAMINER

LE, TAN

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,278

Applicant(s)

DONOVAN, STEPHEN

Examiner

Tan Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 111-163 is/are pending in the application.
- 4a) Of the above claim(s) 119-156 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 111-118 and 157-163 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is the third office action for serial number 09/937,278. This application contains claims numbered 111-163. Claims 1-110 have been canceled by the preliminary amendment filed 3/4/02. Claims 157-163 have been added by the second preliminary amendment filed 7/24/03, which is after the election.
2. Applicant's election without traverse of Group I, claims 111-118 in Paper No. 8 is acknowledged. Claims 157-163 have been added after the election which are also considered as part of a single general inventive concept to Group I.
3. Claims 119-156 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

An examination as follows:

4. The IDS submitted on 1/18/02 has been reviewed and considered.

Drawings

5. The drawings are objected to under 37 CFR 1.84 (b) because black and white photographs of Figs. 6-8, 16 and 30 are not shown sufficient quality to be reproducible in a printed patent. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "means" as

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claimed in claim 113, the "checkerboard configuration" as claimed in claim 118, "the hinge" as claimed in claims 159-161 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claims 112-117 are objected to because the claims preamble appear to be not consistent with the preamble of the independent claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 111-118 and 157-163 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 111 recites the term "if necessary" is unclear as to what or when is necessary that Applicant is intended to claim.

Claim 112 recites the term "similar modular" is unclear as to how similar or what modular that Applicant is intended to be similar.

Claim 117 recites the limitation "the upper external surface". This limitation lacks antecedent basis.

Claim 118 recites the terms "the effective volume (line 2) and "the aggregate volumes" are also unclear as to what Applicant is intended to be effective or aggregate.

Claims 157 and 163, each recites the phrase "in accordance with that of a standard shipping container" is also unclear as to what standard or regulation that Applicant is intended to describe.

Claims 158-162, each recites "wherein the, or the part of the" is also unclear "what "the" that Applicant is intended to point out.

Note that the examiner has attempted to point out many of the terms and/or phrases which lack a clear antecedent basis in the claims and/or to point out those portions of the claims which include indefinite language which affects the intended meaning of the claim language. Applicant is urged to review each and every line of each and every claim to correct the above and to correct any other errors which applicant becomes aware of during the editing of the instant claims. Also, applicant should scrutinize any new claims submitted to insure that the claims comply with the exacting requirements of the statute. See MPEP 2171+.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 111-116 and 157-158 and 162-163 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent no. 4,599,829 to DiMartino, Sr. (see IDS).

Dimartino, Sr. discloses a building system comprising a plurality of transportable modular building units (Fig. 1) wherein the modular units includes means to detachably mount different internal fittings including furniture components (Figs. 8-10 for example). The rest of the limitations recited in claims are considered to be functional in which the modular building units of Dimartino, Sr. is also capable of performing all these functions as recited in claims 111-116, 157-158 and 162-163.

Claims 111-118 and 157-163 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,109,189 to Tarver.

Taver discloses a modular living quarters, comprising a plurality of transportable modular building units (Figs. 1-23) wherein the modular units includes means to detachably mount furniture components; at least one wall is hinged to swing downwardly or upwardly. The rest of the limitations recited in claims are considered to be functional in which the modular units of Taver is also capable of performing all these functions as recited in claims 111-118 and 157-163.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4,050,215 to Fisher

5,257,440 to Bardou et al.

GB 2,266,907 to Basing

FR 2,547,332 to Philippe.

4,833,841 to Ellington, III

The above patents disclose various types of modular building units.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (703) 305-8244.

The examiner can normally be reached on Mon-Fri 9:00-6:00 and alternating Mon..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
March 18, 2004.



LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER